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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,832	06/24/2005	Masayoshi Handa	1422-0680PUS1	2135

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EXAMINER
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ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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3761

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/02/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/02/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Period for Reply

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-15 is/are pending in the application.  
4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claims 10-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: if initially presented along with claims 1-9, claims 10-15 would have been subjected to a restriction requirement on the basis of inventions related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed in claim 1 can be made via a materially different process than the one recited in claim 10, namely polymerizing monomer(s) in the presence of oxygen containing inorganic salt that could be used as a polymerization initiator, thus having residual amount of such salt in a resulting polymer.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Claims 1-7, 9 are examined on the merits, claim 7 is currently amended.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 1-6, 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Obayashi et al (U.S. 4,863,989).

5. Obayashi discloses a water absorbent resin composition comprising a water absorbent resin an oxygen containing inorganic salt and organic antioxidant (abstract). Inorganic salts are listed in col.2, lines 63-68, col.3, lines 1-17 and include each and every specie claimed by Applicant in claims 1 and 2. Organic antioxidants are listed in col.3, lines 42-67, and include each and every claimed specie for such antioxidant. Inorganic salt is present in the amounts 0.01-10% by weight (col. 3, lines 19-21), which anticipates the instantly claimed range, as per claim 3.

Inorganic salt is present in the amount of 0.001-10 parts by weight (col.4, lines 1-5), which anticipates the range for the antioxidant., as per claim 6. The preparation of the absorbent article is described in col.6, lines 5-11.

With regard to the content of iron as being at most 1ppm, nothing in the disclosure of Obayashi shows that any iron content is present (the polymers are not disclosed as being obtained using ferrocene catalysts), and thus the limitation of the claim 1 is met.

Even more, the composition of Obayashi is identical in the content and amounts of ingredients to the claimed composition, and therefore, the rejection is made in the sense of The above rejections were made in the sense of *In re Spada*, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art. The identical compositions cannot have mutually exclusive properties, and therefore the limitation of claim 1 is met.

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Limitations of claim 9 are disclosed in col.6, lines 5-11, wherein the liquid permeable sheet is covered with absorbent composition and further laminated with liquid impermeable layer.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obayashi. Obayashi discloses the use of his composition in the absorbent article for urine retention, however does not specify the content of the resin composition as per claim 8. However, Example "Preparation of an absorbent article" in col.6, lines 5-11 shows the content of the composition close to 95% if calculated using the area of the sheet, basis weight of the pulp and weight of the composition. When the claimed range and the prior art range are very similarly, the range of the prior art establishes *prima facie* obviousness because one of ordinary skill in the art would have expected the similar ranges to have the same properties. See *in re Peterson*, 65 USPQ2d 1379, 1382, citing *titanium Metals Corp. V. Banner*, 227 USPQ 773, 779.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-7, 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/561,450. Although the conflicting claims are not identical, they are not patentably distinct from each other because both set of claims contain water absorbent resin, oxygen containing reducing agent, organic antioxidant. In addition the claims of US'450 contain chelating agent, however, the transitional phrase comprising in the instant claims does not preclude the composition of having any other major components, even in the major amounts, and the use of chelates in such compositions is known to those skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

9. Applicant's arguments filed 12/20/2006 have been fully considered but they are not persuasive. Applicants' argument resides in contention that Obayashi fails to

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disclose or suggest a process which comprises combining materials with an iron content that is small, so as to adjust the total iron content of tile water-absorbent resin composition to 1 ppm or less, and such that discoloration resistance as well as gel stability can be improved. Therefore, the newly added process claims cannot be considered anticipated by, or obvious over, Obayashi '989. In response to this it is noted that claims directed to a process were withdrawn from consideration, as per reasons set forth in this communication. Applicants further acknowledge that the reference discloses the composition similar to the claimed one. Applicants, however, failed to point out and provide an evidence on how the composition of Obayashi is different from the claimed composition. With regard to claim 7 that was amended to incorporate the limitations of cancelled claim 8, the rationale of the obviousness rejection is presented above.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Tatyana Zalukaeva at telephone number (571) 272-1115.

Tatyana Zalukaeva  
SPE  
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A handwritten signature in black ink, appearing to read 'Tatyana', written in a cursive style.